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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,240	05/27/2005	Luca Petrucci	20022/40550	9249
4743 7590 03/17/2008 MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606				
EXAMINER				
PICKETT, JOHN G				
ART UNIT		PAPER NUMBER		
3728				
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03/17/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/511,240

**Applicant(s)**

PETRUCCI ET AL.

**Examiner**

J. Gregory Pickett

**Art Unit**

3728

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-6 and 8-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-6 and 8-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/888)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Office Action acknowledges the applicant's amendment filed 11 December 2007. Claims 1, 3-6, 8-15 are pending in the application. Claims 2 and 7 have been canceled. Claim 15 is new.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Oath/Declaration***

2. The Office is hereby *sua sponte* waiving the express language requirement of 37 CFR 1.63(b)(3), where the oath or declaration was filed prior to 01 June 2008. The express language of 37 CFR 1.63(b)(3) is waived only to the extent necessary such that an oath or declaration containing the "material to examination" or "in accordance with § 1.56(a)" language, or both, will be accepted as acknowledging the applicant's duty to disclose information "material to patentability" as defined in 37 CFR 1.56.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one

skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 15 recites that the “entire upper wall of each packet (3) is completely in direct contact with an upper wall of the airtight outer wrapping (9) without the interposition of any intermediate element”. This represents **new matter** since there is no support for this exclusion in the specification as originally filed. In the remarks, applicant points to Figures 3 and 4 as support for the claim amendments; however since neither of these figures are in cross-section, their arrangement with the upper part of the packet cannot be assumed.

Furthermore, any negative limitation or exclusionary proviso must have basis in the original disclosure (see MPEP 2173.05(i)). The mere absence of a positive recitation is not a basis for exclusion.

#### ***Claim Rejections - 35 USC § 103***

4. Claims 1, 3-6, 8-11, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evers et al (US 5,301,805; previously provided) in view of Barber et al (US 4,351,433; previously provided) and Oemkes (DE 4440555 A1; provided by applicant).

Claims 1 and 3: Evers discloses a 10-pack carton of standard soft-packs or foil packs (Col. 1:38-40), which includes an outer package (carton) and a number of packets (soft-packs) arranged in a given order inside the outer package, and a reusable box (Figures 5-11). Evers anticipates an embodiment wherein the reusable box is

erected with one of the packets (soft-packs) enclosed within, and subsequently placed within the carton (Col. 7:22-33). Evers functions as claimed and discloses the claimed invention except that it lacks the specific description of the soft-packs and provides a flat closure for the reusable box instead of the claimed cup-shaped lid and collar.

As to the soft-pack, Barber discloses a soft pack Barber discloses a soft-pack 10 with an outer package 4/6 with an airtight outer-wrapping 8, and tear-off strip 26 that completely surrounds the top portion (Col. 2:34-36). To provide the packet of Barber within the carton arrangement of Evers would have been obvious in order to provide multiple soft-packs that are less expensive to make (Barber, Col. 1:9-12).

As to the hinged lid, Oemkes discloses an equivalent reusable box 3 for receipt of a soft-pack and having a cup-shaped lid 6 hinged to the container and having an upper opening with a collar (see Figure 1). To replace the box of Evers with a flip-top box as taught by Oemkes would have been obvious in order to enable the user to more easily open the box. Where, as here “[an application] claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result,” KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1395 (citing *United States v. Adams*, 383 U.S. 50-51, 148 USPQ 479, 483 (1966)).

Claim 4: Use of the terminology “printable materials” requires only the ability to receive printing. Both Oemkes and Barber are fully capable of receiving printing.

Claims 5 and 6: Evers anticipates first graphics (Col. 2:9-12) and second graphics (tax stamp).

Claim 8: Oemkes discloses complementary shapes for the box and packet.

Claims 9-11: Cardboard, plastic and metal were all known materials at the time the invention was made and the selection of any of these known materials would have been an obvious matter of design choice to one of ordinary skill in the art.

Claim 15: Evers-Barber-Oemkes, as applied to claim 1 above, discloses the claimed invention except that Barber has a tax-stamp 20 between the outer wrap and the inner wrap. To remove the tax stamp would have been obvious to one of ordinary skill in the art for use in places that either don't tax the product, or require the tax stamp in a different location. It has been held that omission of an element and its function in a combination where the remaining elements perform the same function as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

5. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evers-Barber-Oemkes as applied to claim 1 above, and further in view of Focke et al (US 6,244,017; provided by applicant).

Evers-Barber-Oemkes, as applied to claim 1 above, discloses the claimed invention except for the folded sheet of paper or carton, which functions as a coupon.

Focke teaches a folded sheet 30 of paper (Figures 11 or 12, Col. 3:14-17), which functions as a coupon, provided in a carton of cigarettes. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the carton of Evers-Barber-Oemkes with a folded coupon as taught by Focke, in order to provide

the consumer with an incentive to purchase more of the product. Such a combination would function as claimed.

### ***Response to Arguments***

6. Applicant's arguments filed 11 December 2007 have been fully considered but they are not persuasive.

It is initially noted that the applicant's argument that they believe conventional wisdom would provide an airtight outer wrapping around the carton instead of the individual wrappers is directly in contradiction to their own admission of prior art in the first and second paragraphs of the Background Art.

As to the remaining arguments, Barber discloses the outer wrapping having a tear strip surrounding the packet, and Oemkes discloses the flip-top outer box. "[W]hen the question is whether a patent claiming the combination of elements of prior art is obvious" the relevant question is "whether the improvement is more than the predictable use of prior art elements according to their established functions." *KSR Int 'l Co. v. Teleflex Inc.*, 550 U.S 1727, 1731, 82 USPQ2d 1385 (2007). The claimed invention is no more than the predictable use of prior art elements.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. Gregory Pickett/  
Primary Examiner, Art Unit 3728